

**United States Patent and Trademark Office**

Examiner: Omar, A.

Art Unit: 2838

Docket No. 3731

In re:

Applicant: BERGNER, J.

Serial No.: 10/585,048

Filed: June 29, 2006

**REPLY BRIEF**

March 16, 2010

Hon. Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Sirs:

Responsive to the Examiner's Answer of January 26, 2010, the Appellant submits the following for his Reply Brief and respectfully requests consideration of same. The Appellant requests withdrawal of the rejections made and that the Application be placed in line for Allowance.

## ARGUMENT

In the Answer, the Examiner addresses the rejection of the claims as unpatentable over Mather and Hyodo by maintaining that the claims do not define “separate and distinct receiving areas or that the transport position is not in fact in the standing position”. He argues further that even if the claims could be interpreted as providing separate and distinct receiving areas, Mather discloses a power tool case that includes “a first receiving area for a power tool and a charger and the power tool is stored in a transport position in the first receiving area”. He still maintains that Hyodo discloses a charger with a second receiving area “such that during charging the tool is placed in the standing position and the tool is charged via charging contacts”.

Regarding the rejection of the claims as obvious over Burrus, IV in view of Hyodo, the Examiner argues that modifying Burrus, IV with Hyodo would not lead the practitioner to replace the receiving area of Burrus, IV with that of Hyodo, but instead to add the second receiving area of Hodo to the power tool case of Burrus.

On pages 16-17 of the Answer, the Examiner actually agrees with the Appellant's argument regarding the combination of Burrus IV and Hyodo, but then again argues that the solution would be to add a second receiving area, in spite of the fact that neither reference discloses or suggests such a modification!

Claim 1 of the present application defines a device with a power tool case (10), having:

1) at least one first receiving area (12) for a power tool (16), and a charger (14), wherein the charger (14) and the power tool (16) are designed to remain

connected during a charging procedure and wherein said power tool (16) is stored in its transport position in said first receiving area (12); and

2) a second receiving area, in which the power tool is arranged during the charging procedure in a standing position.

Contrary to the Examiner's position, the claimed invention does indeed define separate first and second receiving areas. Mather discloses providing a case (1) with one storage area for a power tool in the event of transportation and storage, respectively (see Mather, Fig. 1 and page 1, lines 1 to 3). Hyodo et al teaches arranging an impact screwdriver (1) in an upright position in a charger (20) (see Hyodo et al, Fig. 10, and the abstract).

Both Mather and Hyodo each disclose one receiving area. Even if Hyodo could be interpreted to disclose that the power tool can be stood in the area during charging, this feature does NOT support modification of either of the primary references to add a second receiving area for this purpose.

From the teachings of Hyodo, the practitioner would be taught to modify Mather to provide one receiving area in which the tool could be charged in a standing position rather than stored in a lying position, since neither Mather nor Hyodo even mentions the possibility of providing two receiving areas.

Regarding the combination of the Burrus reference with Hyodo, Burrus teaches away from the present invention by specifically disclosing that the power tool (104) is disposed in a lying position during charging. No motivation exists that would lead the practitioner to modify this structure. In fact, the modification proposed by the Examiner contradicts the Burrus disclosure: Burrus discloses charging the power tool during

transport when the vehicle is in motion, so that a standing arrangement of the power tool would be unstable.

Since none of the references suggests that a second area could be added to the case, the Examiner's analysis that a practitioner would be led to such an extensive modification of the art without any specific suggestion from any of the art constitutes impermissible hindsight. When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. ***ACS Hosp Sys., Inc., v. Montefiore Hosp.***, 221 USPQ 929, 932, 933 (Fed. Cir. 1984).

In view of the foregoing discussion, it is again respectfully requested that the Honorable Board of Patent Appeals and Interferences overrule the final rejection of claims 1-12 and 14-20 over the cited art, and hold that Appellant's claims be allowable over such art.

Respectfully Submitted,



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